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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,094	11/05/2003	Robert P. Madill JR.	5053-64100	6815
35690 7590 08/23/2007 MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C. P.O. BOX 398 AUSTIN, TX 78767-0398			EXAMINER WINTER, JOHN M	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/702,094	Applicant(s) MADILL ET AL.	
	Examiner John M. Winter	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 66, 67, 69- 83, 101, 134 and 159-163 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 66, 67, 69- 83, 101, 134 and 159-163 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

The Applicants amendment filed on March 24, 2006 is acknowledged, Claims 66,67, 69-83,101, 134 and 159-163 remain pending .

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Response to Arguments

The Applicants arguments filed on June 7, 2007 have been fully considered.

The Applicant suggests that the cited references do not teach to the limits of the applicants claims, the examiner states that according to *In re Oetiker*, 24 USPQ2d 1443,1445 (Fed. Cir 1992) A prior reference is analogous if the reference is in the filed of the applicant's

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endeavor or, if not, the reference is reasonable pertinent to the particular problem with which the inventor is concerned.

Examiner states that the Pendleton, Jr. (US Patent 6,253,186) reference discloses the amended feature of “determining a weighted combined fraud potential indicator that combines at least the first fraud potential indicator assessed using the first fraud technique and the second fraud potential indicator assessed using the second fraud technique, wherein, in combining the first fraud potential indicator and the second fraud potential indicator, the first fraud potential indicator is weighted differently from the second fraud potential indicator; and referring the request for review if the combined or weighted combined fraud potential indicator exceeds a threshold value, wherein the threshold value is adjusted to control the number of requests with the weighted combined fraud potential indicator exceeding the threshold value.”

See following rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 66, 76, 80 and 134 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite the limitation “if the weighted combined fraud indicator potential exceeds a threshold value....” this limitation is vague and indefinite.

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Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: " Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original]." As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 66,67, 69- 83,101, 134 and 159-163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torres et al., (US Patent Application No 2005/0043961) and further in view of Pendleton, Jr. (US Patent 6,253,186)

As per claim 66,

Torres et al. ('961) discloses a method, comprising:

providing at least two fraud potential indicators for at least one request,;(paragraph 21)

A first fraud potential indicator assessed using a first fraud potential detection technique and a second fraud potential indicator is assessed using a second fraud potential detection

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technique, wherein the first fraud potential technique is different from the second fraud potential detection technique.(paragraph 23)

displaying a score or rank for at least the first and second fraud potential indicators in a graphical user interface.(Figure 7)

determining a combined or weighted fraud potential indicator that is based on at least the first fraud potential indicator and the second fraud potential indicator.(Paragraphs 22 and 43)

Torres et al. discloses the claimed invention except for “two fraud potential indicators“, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two fraud potential indicators, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Torres et al. ('961) does not explicitly disclose determining a weighted combined fraud potential indicator that combines at least the first fraud potential indicator assessed using the first fraud technique and the second fraud potential indicator assessed using the second fraud technique, wherein, in combining the first fraud potential indicator and the second fraud potential indicator, the first fraud potential indicator is weighted differently from the second fraud potential indicator; and referring the request for review if the combined or weighted combined fraud potential indicator exceeds a threshold value, wherein the threshold value is adjusted to control the number of requests with the weighted combined fraud potential indicator exceeding the threshold value.

Pendleton, Jr. ('186) discloses determining a weighted combined fraud potential indicator that combines at least the first fraud potential indicator assessed using the first fraud

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technique and the second fraud potential indicator assessed using the second fraud technique, wherein, in combining the first fraud potential indicator and the second fraud potential indicator, the first fraud potential indicator is weighted differently from the second fraud potential indicator; and referring the request for review if the combined or weighted combined fraud potential indicator exceeds a threshold value, wherein the threshold value is adjusted to control the number of requests with the weighted combined fraud potential indicator exceeding the threshold value. (column 7, lines 31-59) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Torres et al. ('961)'s method with Pendleton, Jr. ('186)'s teaching in order to determine the rate of increase of fraudulent claims; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

Torres et al. ('961) does not explicitly disclose referring the request for review if the combined or weighted fraud potential indicator exceeds a threshold value wherein the threshold value is adjusted to control the number of requests with combined or weighted fraud potential indicator exceeding the threshold value. Pendleton, Jr. ('186) discloses referring the request for review if the combined or weighted fraud potential indicator exceeds a threshold value wherein the threshold value is adjusted to control the number of requests with combined or weighted fraud potential indicator exceeding the threshold value. (column 7, lines 35-59) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Torres et al. ('961)'s method with Pendleton, Jr. ('186)'s teaching in order to determine the rate of increase of fraudulent claims; furthermore the combination of these elements does not alter their

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respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

Claims 76, 80, 134 and 162 are in parallel with claim 66 and are rejected for at least the same reasons.

As per claim 67,

Torres et al. ('961) discloses the method of claim 66,

wherein clicking on at least one fraud potential indicator for the at least one request will display information about the at least one request. (paragraph 47, figure 7)

As per claim 69,

Torres et al. ('961) discloses the method of claim 66, further comprising

wherein at least one request is an insurance claim, and at least one insurance claim is organized into lists according to at least two of referred claims, assigned claims, or rejected claims, and wherein selecting a graphical component respective to at least one of a referred claims, desired claims, or rejected claims brings up a list of claims in the corresponding list.(Figure 9)

As per claim 70,

Torres et al. ('961) discloses the method of claim 66, further comprising

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further comprising changing a criteria about which claims to display by selecting a filter graphical component. (Figure 8)

As per claim 71,

Torres et al. ('961) discloses the method of claim 66, further comprising assigning at least one request by selecting an desired graphical component. (Figure 7)

As per claim 72,

Torres et al. ('961) discloses the method of claim 66, further comprising rejecting at least one request by selecting a reject graphical component.(Figure 1)

As per claim 73,

Torres et al. ('961) discloses the method of claim 66,
wherein at least one fraud potential detection technique comprises predictive modeling.(Paragraph 21)

Claims 77 and 81 are in parallel with claim 73 and are rejected for at least the same reasons.

As per claim 74,

Torres et al. ('961) discloses the method of claim 66,

Official Notice is taken that "at least one fraud potential detection technique comprises at least one identity search of insurance claim data" is common and well known in prior art in reference to fraud detection protocols. It would have been obvious to one having ordinary skill

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in the art at the time the invention was made to use an identity search in order to expose any aliases that the claim filer may have used in the past.

Claims 78 and 82 are in parallel with claim 74 and are rejected for at least the same reasons.

As per claim 75,

Torres et al. ('961) discloses the method of claim 66,

wherein at least one fraud potential detection technique comprises assessing request data using at least one business rule(Paragraph 21).

Claims 79 and 83 are in parallel with claim 75 and are rejected for at least the same reasons.

As per claim 159,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud potential indicators is a predictive modeling engine, and wherein displaying the score or rank for the first and second fraud potential indicator comprises displaying information on at least one match used by the business rules engine to assign the fraud potential indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for "two fraud potential indicators", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two fraud potential indicators, since it has been held that mere duplication of the

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essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claim 160,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud potential indicators is a identity search engine, and wherein displaying the score or rank for the first and second fraud potential indicator comprises displaying information on at least one match used by the business rules engine to assign the fraud potential indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for "two fraud potential indicators", It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two fraud potential indicators, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

As per claim 161,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud potential indicators is a business rule engine, and wherein displaying the score or rank for the first and second fraud potential indicator comprises displaying information on at least one match

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used by the business rules engine to assign the fraud potential indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for “two fraud potential indicators“, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use two fraud potential indicators, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 163 is parallel with claim 161 and is rejected for at least the same reasons.

Conclusion

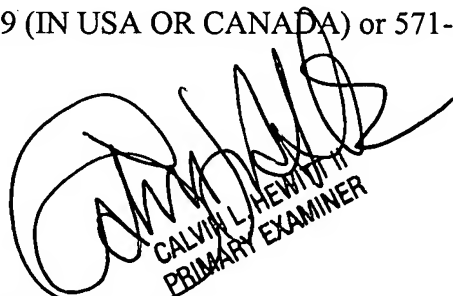
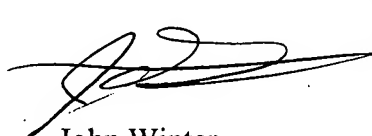
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



CALVIN L. HEWITT II
PRIMARY EXAMINER

John Winter

Patent Examiner -- 3621